

REMARKS

Reconsideration and allowance of the subject application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 1-17 and 19-25 remain pending. Claim 1 has been amended to clarify terminology and correct the inadvertent error regarding the discrepancy between the clean and amended version of claim 1 in the Amendment submitted concurrent with the Request for Continued Examination filed June 20, 2003. Claims 2, 3, 4 and 5 have been amended to correct inadvertent typographic errors regarding amended claim 1 from which they depend. Claim 26 has been added to secure a scope of protection to which applicants are believed entitled.

At the outset, applicant's attorney thanks the Examiner for the courtesies extended during a telephonic interview held on November 18, 2003. The interview discussion focused on the status of previously cancelled claim 18 and the interpretation of the connection between hat section 38 and side cover 35 of the Babcock reference. The Examiner stated that claim 18 is to be considered cancelled for the purposes of responding to the present Official Action. Therefore, the objections and rejections related to claim 18 are understood as having been withdrawn. ✓

The rejection of claim 1-7 under 35 U.S.C. 112, second paragraph, as being indefinite is believed to be overcome by the foregoing amendments and is hereby traversed as it is believed that the scope of the claims is reasonably ascertainable by those skilled in the art. For either of the above reasons, the rejection of claims 1-7 should be withdrawn.

The rejection of claims 1-6 under 35 U.S.C. 102(b) as being anticipated by Johnson (U.S. Patent 3,803,670) is believed overcome in view of the foregoing amendments. Johnson fails to teach or describe a computer case cover panel for attachment to a side panel of a computer case as claimed in claim 1. For at least this reason, the rejection of claims 1-6 should be withdrawn. ✓

Claim 7 depends from claim 1 and for at least the reason advanced above with respect to claim 1, the rejection of claim 7 under 35 U.S.C. 103(a) as being unpatentable over Johnson ✓

should be withdrawn.

The rejection of claims 1-25 under 35 U.S.C. 103(a) as being unpatentable over Babcock et al. (U.S. Patent 5,890,783) in view of the Johnson reference is hereby traversed. There are at least three reasons the Examiner is incorrect and the rejection should be withdrawn: erroneous interpretation of the plain meaning of claim terms, erroneous interpretation of reference, and lack of motivation to combine the references.

First, the Examiner erroneously attempts to interpret the side panels and cover panels of the present claimed invention as covering the frame corner post 34 and the hat section 38, respectively, of Babcock. However, the Examiner's interpretation of the terms as covering the frame corner post and the hat section is unreasonable and inconsistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). See also MPEP Section 2111 Claim Interpretation; Broadest Reasonable Interpretation, “[t]he broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach” and Section 2111.01 Plain Meaning, specifically sub-heading “Plain Meaning” Refers to the Meaning Given to the Term by Those of Ordinary Skill in the Art, “the words of a claim must be given their plain meaning. In other words, they must be read as they would be interpreted by those of ordinary skill in the art.”

A person of ordinary skill in the art would interpret the term side panel as being analogous to side cover 35 and the frame corner post 34 as a portion of the frame and not a side panel. For example, U.S. Patent 5,964,513 to Korinsky et al. includes side panels 600 analogous to the present claimed side panels. The frame corner post 34 of Babcock is more closely related to the chassis, more specifically a portion of the frame 300, 400, of Korinsky. Side cover 35 of Babcock is analogous to side panels 600 of Korinsky.

Further, U.S. Patent 5,947,570 to Anderson et al. includes side panels 86 analogous to the side panels of the present invention. The frame corner post 34 of Babcock is more closely related to the “underlying enclosure, such as a frame,” “that gives strength and shape to the

modular cabinet.” Anderson at column 1, lines 50-53 and column 5, lines 43-44, respectively. Side cover 35 of Babcock is analogous to side panels 86 of Anderson.

Based on the above and as evident from the specification as originally filed, side cover 35 of Babcock is analogous to the side panel of the present invention and not the cover panel of the present invention. Babcock does not contain any element analogous to the cover panel of the present invention.

Second, hat section 38 of Babcock is described as being connected to an inner surface 33 of side cover 35. More particularly, Babcock suggests the connection of hat section 38 to side cover 35 is a permanent connection by teaching the use of spot-welding as a technique to form the connection. Babcock fails to describe affixing hat section 38 to frame corner post 34 without being connected to side cover 35. Therefore, hat section 38 is more appropriately considered a part of side cover 35. Side cover 35 is analogous to the side panel of the present invention. As described above, frame corner post 34 of Babcock is analogous to the frame of a computer case and further because, as described immediately above, hat section 38 is a connected part of side cover 35, there remains no additional element of Babcock analogous to the cover panel of the present claimed invention.

Third, the Examiner has failed to identify any motivation or suggestion in either reference teaching, suggesting, or describing the asserted combination. The Examiner’s argument that the arrangement would allow the panels to be fastened together without the use of tools, thereby conserving time and saving money has no basis in either reference and is, in fact, counter to the teaching of the Babcock reference. The Examiner appears to have improperly applied hindsight reasoning based on the present invention to make the asserted combination.

Specifically, the Examiner has failed to identify why a person of ordinary skill would be motivated to combine the teaching of Babcock with the fastener device of Johnson. As admitted by the Examiner, nowhere does Babcock describe an elastomeric foot. Further, Babcock is directed to constructing a computer case using a semi-monocoque design in order to increase structural integrity of the frame, e.g., “the frame must withstand up to 4800 lbs. in dynamic

compression and buckling forces.” Babcock at column 2, lines 1-2. The Johnson fastener device is directed to fastening lapped panels, e.g., “for use with corrugated cardboard panels each having a thickness of 0.141 inches and a Mullen punch test rating of 275 pounds.” Johnson at column 3, lines 63-65. The flexible nature of the Johnson fastening device is counterproductive to the structural desire of the semi-monocoque Babcock design.

Further still, use of the Johnson fastener device in combination with the Babcock computer case renders the Babcock side cover 35 permanently in place on the computer case 44. Assuming screws 32 are replaced with the Johnson fastener device, the fasteners once passed through holes 33 in frame corner post 34 and on into holes 33 in stiffener hat section 38 are no longer removable due to the location of side cover 35 connected to hat section 38. Side cover 35 thereby prevents access to the lobes of the Johnson fastener device preventing shifting the lobes inwardly toward each other to disengage the abutment surfaces. Because the Johnson fastener device is non-removable from the Babcock case once in place, the removal of removable side cover assembly becomes much more complicated, if not impossible, and a need satisfied by Babcock, “the need for a side access to the internal machinery enclosed” (Babcock at column 2, lin26-27) and “the cover of such an electronic device enclosure must be readily removable” (Babcock at column 1, lines 58-59), is not satisfied. That is, the proposed modification would render the Babcock device being modified unsatisfactory for its intended purpose and there can be no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

A statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill of the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. See MPEP 2143.01 quoting Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). The Office Action merely stated that the reference can be modified, which applicants contend to the contrary, and does not state any desirability in either reference for making the modification. In other words, the Office Action failed to supply any objective reasons to modify the applied reference.

In accordance with MPEP §2143.01 and Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999), the Examiner is requested to identify a teaching, suggestion, or motivation in either reference providing a motivation or suggestion to one of ordinary skill in the art to make the argued combination or provide an affidavit or declaration setting forth specific factual statements and an explanation supporting his finding. The Examiner has not identified any teaching in Babcock or Johnson motivating or suggesting the asserted combination to a person of ordinary skill in the art because there is no teaching to be found. For at least this reason, the rejection should be withdrawn.

“When an obviousness determination is based on multiple prior art references, there must be a showing of some ‘teaching, suggestion, or reason’ to combine the references.” Winner International Royalty Corp. v. Wang, 53 USPQ2d 1580, 1586 (Fed. Cir. 2000). The Examiner has failed to make such a showing supporting the applied combination of references and therefore the applied combination of references is improper. The Examiner is in error for any of the above reasons and has not made out a *prima facie* case of obviousness, and the rejection of claim 1 should be withdrawn.

For any of the above reasons, claim 1 is patentable over the applied combination of references and the rejection should be withdrawn. Claims 8, 11, and 19 are patentable for reasons similar to those advanced above with respect to claim 1 and the rejection of claims 8, 11, and 19 should be withdrawn. Claims 2-7, 9-10, 12-17, and 20-25 depend, either directly or indirectly, from claims 1, 8, 11, and 19, respectively, including further important limitations, and are patentable over the applied combination of references for at least the reasons advanced above with respect to claims 1, 8, 11, and 19, respectively. The rejection of claims 2-7, 9-10, 12-17, and 20-25 should be withdrawn.

All objections and rejections having been addressed, it is respectfully submitted that the present application should be in condition for allowance and a Notice to that effect is earnestly solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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